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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,109	06/23/2003	Kevin R. Manke	2001-IP-004117 UID1 USA	7240
20558	7590	12/17/2003	EXAMINER	
KONNEKER & SMITH P. C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			JACKSON, ANDRE K	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/602,109

**Applicant(s)**

MANKE ET AL.

**Examiner**

André K. Jackson

**Art Unit**

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The application is objected to because of alterations, in the claims, which have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by application number and filing date is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4,8 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jessup (3762219).

Regarding claim 1, Jessup discloses in "Apparatus for conducting controlled well testing operations" installing a test apparatus on the wellbore, the test apparatus including a fluid barrier reciprocally displaceable within the apparatus, the barrier having first and second sides; flowing fluid from the formation into the apparatus on the first side of

the barrier, the barrier displacing in a first direction in the apparatus as the formation fluid flows into the apparatus and applying pressure to the apparatus on the second side of the barrier, thereby displacing the barrier in a second direction opposite to the first direction in the apparatus and forcing the formation fluid to flow back into the formation from which the fluid originated (Abstract, Figs. 1a-1f).

Regarding claim 2, Jessup discloses where in the installing step the apparatus includes a tubular string extending to a remote location and where the barrier is axially reciprocally received in the string (Figures 1a-1f).

Regarding claim 3, Jessup discloses where pressure is applied to the string at the earth's surface to displace the barrier downwardly (Figures 1a-1f).

Regarding claim 4, Jessup discloses where the barrier is a plug sealingly received in a bore of the apparatus (Figures 1a-1f).

Regarding claim 8, Jessup discloses where the apparatus includes a tubular string extending to a remote location and the flow passage is in fluid communication with an interior of the tubular string (Figures).

Regarding claim 19, Jessup discloses a fluid barrier reciprocally displaceable within an apparatus into which fluid from the formation is flowed, the barrier displacing when the formation fluid is flowed between the apparatus and the formation and a valve in the apparatus the valve

being operated in response to displacement of the barrier (Columns 1 and 2).

Regarding claim 20, Jessup discloses where the valve operates in response to displacement of the barrier in a first direction and where the barrier displaces in the first direction when formation fluid is flowed into the apparatus (Columns 1-2, Figures 1a-1f).

Regarding claim 21, Jessup discloses where the valve closes in response to displacement of the barrier in the first direction (Columns 1-2, Figures 1a-1f).

Regarding claim 22, Jessup discloses where the valve operates when the barrier displaces in a second direction opposite the first direction and where the barrier displaces in the second direction when formation fluid is flowed out of the apparatus (Columns 1-2, Figures 1a-1f).

Regarding claim 23, Jessup discloses where the apparatus includes a tubular string positioned in the wellbore, the tubular string having an interior in fluid communication with a flow passage extending through the valve (Figures 1a-1f).

Regarding claim 24, Jessup discloses where the barrier displaces in the first direction closing the valve and preventing flow through flow passage, when the pressure in the tubular string interior is less than the pressure formation and the barrier displaces in the second direction and the valve opens thereby permitting flow through the flow passage, when

pressure in the tubular string interior is greater than pressure in the formation (Columns 1-2).

4. Claims 1,8-10,13-16,25 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Christensen (EP0295922).

Regarding claim 1, Christensen discloses in "Downhole tool and method for perforating and sampling" installing a test apparatus on the wellbore, the test apparatus including a fluid barrier reciprocally displaceable within the apparatus, the barrier having first and second sides; flowing fluid from the formation into the apparatus on the first side of the barrier, the barrier displacing in a first direction in the apparatus as the formation fluid flows into the apparatus and applying pressure to the apparatus on the second side of the barrier, thereby displacing the barrier in a second direction opposite to the first direction in the apparatus and forcing the formation fluid to flow back into the formation from which the fluid originated (Abstract, Figures 1-5).

Regarding claim 8, Christensen discloses where the apparatus includes a tubular string extending to a remote location and the flow passage is in fluid communication with an interior of the tubular string (Figures).

Regarding claim 9, Christensen discloses where pressure is applied to the interior of the tubular string, the valve opens in response to the pressure, and the pressure is communicated through the open valve

from the tubular string interior to the barrier second side (Column 3, Figures 1-5).

Regarding claim 10, Christensen discloses where setting at least one packer of the apparatus in response to displacement of the barrier in the second direction prior to the flowing step (Columns 1-6).

Regarding claim 13, Christensen discloses where opening a waste chamber (sampling chamber) prior to flowing the formation fluid into the apparatus of the waste chamber (sampling chamber) permitting wellbore fluid flow into the waste chamber (Abstract, Columns 1-6).

Regarding claim 14, Christensen discloses where the waste chamber (sampling chamber) opening step is performed in response to pressure applied to an annulus formed between the apparatus and the wellbore (Abstract, Columns 1-3).

Regarding claim 15, Christensen discloses where setting at least one packer of the apparatus in the wellbore before the flowing step where the waste chamber (sampling chamber) opening step is performed after the setting step (Columns 1-6).

Regarding claim 16, Christensen discloses where there are multiple waste chambers (sampling chambers) and where the waste chamber (sampling chamber) sampling step has sequentially selectively opening each of the waste chambers (sampling chambers) (Abstract, Columns 1-6).

Regarding claim 25, Christensen discloses where at least one packer interconnected as part of an apparatus positioned in the wellbore; a fluid barrier reciprocally displaceable within the apparatus when fluid is flowed between the apparatus and the formation and a module interconnected to the packer, the module alternately permitting and preventing setting and unsetting of the packer in response to reciprocal displacements of the barrier

Regarding claim 28, Christensen discloses a formation testing apparatus including at least one waste chamber and at least one packer configured for isolating the formation when set in the wellbore and the waste chamber being opened in response to pressure in an annulus formed between the apparatus and the wellbore after the packer is set (Abstract, Columns 1-2).

Regarding claim 29, Christensen discloses where the waste chamber (sampling chamber) receives fluid in the wellbore from the annulus when the waste chamber is opened (Abstract, Columns 1-2).

Regarding claim 30, Christensen discloses where there are multiple waste chambers (sampling chambers) and where there are multiple formations intersected by the well bore and further comprising a module of the apparatus which opens each of the waste chambers in sequence prior to a corresponding one of the formations being tested (Abstract, Columns 1-2).



5. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Beck (5887652).

Regarding claim 28, Beck disclose a formation testing apparatus including at least one waste chamber and at least one packer configured for isolating the formation when set in the wellbore and the waste chamber being opened in response to pressure in an annulus formed between the apparatus and the wellbore after the packer is set (Columns 1-2).

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,622,554. Although the conflicting claims are not identical, they are not patentably distinct from each other because they

are not patentably distinct from each other because of the following comparisons: Patented claim 1 contains all of the limitations of the application claim 1 and is narrower in scope than the application claim. The additional claim limitation is "the barrier preventing flow therethrough when formation fluid is flowed into the test apparatus". The patented claims therefore encompass the scope of the application claim, which necessitates the double patenting rejection.

Patented claim 19 contains all of the limitations of the application claim 19 and is narrower in scope than the application claim. The additional claim limitation is "the barrier preventing flow therethrough when formation fluid is flowed into the test apparatus". The patented claims therefore encompass the scope of the application claim, which necessitates the double patenting rejection.

Patented claim 25 contains all of the limitations of the application claim. The patented claims therefore encompass the scope of the application claim, which necessitates the double patenting rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to André K. Jackson whose telephone number is (703) 305-1522. The examiner can normally be reached on Mon.-Thurs. 7AM-4PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (703) 305-4705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A.J.



December 12, 2003



HEZRON WILLIAMS  
SUPERVISORY PATENT EXAMINER  
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